

Application No. 10/028,027
Amendment dated November 17, 2004
Reply to Office Action of August 19, 2004

REMARKS

Claims 1 – 23 are presented for Examiner Kidwell's consideration.

Claims 8 – 12, 14, 16, 18, and 19 were amended to reflect proper Markush form as suggested by Examiner Kidwell.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

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Responses to Rejections

By way of the Office Action mailed 08/19/2004, claims 8 – 12, 14, 16, 18 and 19 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

Applicants have amended the claims to reflect proper Markush form as suggested by Examiner Kidwell.

By way of the Office Action mailed 08/19/2004, claims 1 – 23 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated and thus unpatentable over U.S. Patent Number 5,635,191 to Roe *et al.* This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 referencing *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); see also *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Also, "[t]he identical invention must be shown in the as complete detail as is contained in the . . . claim." M.P.E.P. § 2131 (citing *Richardson*, 868 F.2d at 1236 (Fed. Cir. 1989). Roe fails to teach each and every element of claims 1 and 7 of the present invention, either expressly or inherently, and is therefore an improper basis for an anticipation rejection. This rejection should be withdrawn.

The Examiner contends that the Roe reference discloses the specifics of the composition as fully explained in the rejection of claim 7, thereby providing a composition that will yield similar results when subjected to the Tangent Delta Measurement Procedure (OA at page 4). Applicants disagree with the Examiner's assertion because Roe does not disclose the composition of the present invention as discussed below.

Applicants' claim 7 requires a composition containing from about 0.1 to about 20 percent by weight silicone elastomer. The Examiner contends that Roe discloses from about 0.1 to about 20 percent by weight of silicone elastomer and cites column 12, lines 29 – 61 for support. (OA at page 4). Applicants respectfully disagree with the Examiner because Roe discloses silicones, such as fluids and waxes, but not silicone elastomers. Roe discloses siloxanes that are linear siloxane polymers. These are in the form of fluids and waxes but do not form elastomers as

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required by Applicants' claims. The siloxane elastomers as claimed are highly crosslinked, branched polymers – not linear polymers like *Roe* discusses. The silicone elastomers are formed from polysiloxane linkages as described on page 27, line 32 through page 28, line 12 of Applicants' disclosure. Since the elastomers have crosslinked and branched structures, they have properties and structure differing from the linear siloxane polymers taught in *Roe*. Because *Roe* fails to teach each and every element of Applicants' claim 7, Applicants' respectfully request the Examiner withdraw this rejection.

Claims 8 – 23 depend from claim 7 and are patentable for at least the same reasons as claim 7 discussed above. Because the composition of claim 7 was not taught by *Roe*, the Examiner's contention regarding claim 1 is improper and the rejection should be withdrawn. Likewise, the rejections of claims 2 – 6, which depend from claim 1, should be withdrawn.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-3016.

Respectfully submitted,

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